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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,208	03/09/2001	Toshiyuki Moritsu	10721-9US	8571
24956	7590	02/27/2006	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/803,208	Applicant(s) MORITSU ET AL.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-32 are pending. The rejections are as stated below.

Claim Objections

2. Claim 22 is objected to because of the following informalities: Claim 22 recites "module changes the payment status to past due *when funds no electronic data* relating to the deposit account identification is received" (Emphasis added). Examiner respectfully points out a possible typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 20, 23, 26, 27, 30, 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Claims 7, 20, 23, 26, 27, 30, and 32 are drawn to a "system". It is unclear whether the claimed "system" is an apparatus or a method, rendering the patent protection desired by the applicant indefinite.

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps or elements, such omission amounting to a gap between the steps or between the elements. See MPEP § 2172.01. Specifically, claim 19 reads "the recipient system records electronic data relating to the payment intention to an IC card for authenticating the recipient." It is unclear how recording data relating to the payment intention relates to authenticating the recipient.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-10, 17, 18, 20, 21, 23-32 are rejected under 35 U.S.C. 102(a) as being anticipated by Chang et al. U.S. Patent No. 5,884,288.

8. Claims 1-10, 17, 18, 20, 21, 23-32, Chang discloses a method and system for electronic bill payment using a payor/payee bank as an intermediary, and using signed certificates to encrypt data for secure transactions (column 2 lines 39-58), comprising:

Claims 1-8, 20, 23-32, a payor sending payment instruction data to an intermediary indicating a request to transfer funds, including a date for the payment to be made, either immediately or in the future (column 8 lines 62-67), the data being sent from the intermediary to the payee (column 7 lines 25-30), the payee sending account information data to the intermediary in response to the payment instruction data (column 7 lines 25-30), and the intermediary transferring funds to the payee's account as indicated in the payment instructions (column 2 lines 51-58).

Claim 9, Chang inherently teaches a bank verifying the existence of an account before processing a transfer of funds into the account.

Claim 10, Chang teaches the payment instruction data including a payment data inherently teaches the payment instruction data including the payment amount (column 8 lines 62-67), and inherently teaches the data including a payment amount and a payee.

Claim 17, Chang teaches the payor's/payee's bank transferring funds to the payee's account as indicated in the payment instructions, and by the payee's account information data (column 2 lines 51-58).

Claim 18, Chang teaches the intermediary sends notification of the pending payment instruction data to the payee (column 7 lines 25-30).

Claim 21, Chang inherently teaches the system changes the status to paid when transactions have been completed (column 6 lines 56-61).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 11-16 are rejected under U.S.C. 103(a) as being unpatentable over Chang as applied to claim 7 above, and further in view of Smorodinsky, U.S. Patent No. 6,049,786.

Claims 11-16, Chang fails to teach the use of hash values in the encryption of digitally signed transmissions, storing transactions, along with their hash values, in a database, decrypting incoming transmissions, and verifying their authenticity by comparing extracted hash values with known values from the database.

Smorodinsky discloses an electronic bill payment system employing hashes and digital signatures, a biller computer having a database which stores a plurality of complete bills and a respective hash which is digitally signed, decrypting digitally signed hashes and comparing them with new hashes to determine whether or not the transmission is authentic (column 2 lines 40-67). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chang to include hashes and digital signatures because Chang teaches that the electronic transactions that are transmitted utilize a digital signal and certification protocol, and any of the well known digital signature and certification protocols can be used (column 7 lines 63-66).

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Yu et al., U.S. Patent No. 6,067,621.

Claim 19, Chang fails to teach transmitting data to an IC card for authentication, and deleting the data before the IC card is removed.

Yu discloses a user authentication system for authenticating an authorized user of an IC card, for the purpose of a secure financial transaction, transmitting an access key to the IC card for user authentication, and deleting the information before the card is removed (column 9 lines 35-53). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chang to include Yu's teachings of user authentication using an IC card because Chang teaches that the electronic transactions that are transmitted utilize a digital signal and certification protocol, and any of the well known digital signature and certification protocols can be used (column 7 lines 63-66).

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang.

Claim 22, Chang fails to teach changing the payment status to past due when the transaction is not completed within the payment period or payment due date. Official notice is taken that changing the status of a bill to past due when it is not paid by its due date is old and well known in the art. It would be obvious to modify the teachings of Chang to include this step because it is vital to a financial obligation that both the payor and payee of a transaction be aware of past due obligations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER